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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,670	08/06/2002	Chia-Lin Chang	ACSP0004USA	5326

27765 7590 05/24/2004

NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,670

Applicant(s)

CHANG ET AL.

Examiner

Alexander Eisen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaoka et al., (hereinafter Nagaoka), US 6,361,232 B1 in view of Yoshimura, US 5,850,059.

Nagaoka discloses a pen for inputting to a touch panel comprising a contact body (tip 12); an intra-body (receiving member 11) comprising a front section and heavyweight section; a front tube (front barrel 10) comprising a narrow opening formed at one end for clipping the contact body and a hole on the opposite side of the tube for packaging the intra-body; a rear pillar tube 1 for packaging the rear section of the intra-body comprising a pillar (bushing 6); a rear pen sheath 7 for packaging the pillar.

Nagaoka does not disclose a rubber pen sheath for packaging the heavyweight section and for increased comfort.

Yoshimura teaches a touch input pen having a grip portion 4 with a rubber ring 18 put thereon for reliable grip and comfort (FIGS. 1-4; col. 3, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to use the rubber ring taught by Yoshimura in the pen of Nagaoka, because it would improve overall grasp of the pen by a user and prevent slippage of the head portion due to increased frictional force (col. 3, lines 60-67).

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As to claim 2, the contact body 12 in Nagaoka is made of plastic (col. 3, lines 53-54).

As to claim 3, some inner parts of the pen are made from a metal (col. 2, lines 12-14) and it would be obvious to one of ordinary skill in the art at the time when the invention was made that any other parts can be also made of plastic or metal, which would simply constitute a matter of user's choice depending on design requirements.

As to claim 4, the heavyweight section can be made of any weight comparably to the front section and rear section, 1.5 to 3.5 times of their respective gross weights including, and it would not be a burden to those of ordinary skilled in the art to do so without unduly experimentation.

As to claim 5, it would be obvious to make various parts of the pen from the plastic for the same reasoning as applied to claim 3.

As to claim 6, Nagaoka teaches a decorative design formed on the surface of the pen (see FIG. 3) for improving the grip of the pen by the user, and it would be obvious to have such a design on the rubber-gripping portion of the pen of Yoshimura.

As to claim 7, it would have been obvious to one of ordinary skill in the art at the time of the invention that the rear sheath can be made of plastic of any color, and can be of any various types.

As to claim 8, Nagaoka teaches that the rear pen sheath 7 has a protruding clipper 9.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988.

The examiner can normally be reached on M-F (9:00 a.m. - 4:00 p.m.).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (703) 305-4709.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or **faxed to:**

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized flourish at the end.

Alexander Eisen
May 19, 2004